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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,878	04/11/2005	Eric Holmen	PIP132HOLM-US	2258
31518 7590 11/27/2009 NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304			EXAMINER GARTLAND, SCOTT D	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 11/27/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/530,878	<b>Applicant(s)</b> HOLMEN ET AL.	
	<b>Examiner</b> SCOTT D. GARTLAND	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44,87-89 and 91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44,87-89 and 91 is/are rejected.
- 7) ☒ Claim(s) 1-3,9-15,19-21,26-28,43,44,87-89 and 91 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04-11-2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status***

1. This Office Action is in response to the communication filed on April 11, 2005. Claims 45-86 and 90 have been cancelled, claim 91 has been amended, and no claims have been added. Therefore, claims 1-44, 87-89, and 91 are pending and presented for examination.

### ***Priority***

2. Applicant's claim for the benefit under 35 U.S.C. 371 to PCT/US02/31609, filed on October 31, 2002, is acknowledged.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on April 11, 2005 was filed on or after the mailing date of the application on April 11, 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

4. The disclosure is objected to because of the following informalities: paragraph 0105 of Applicant's specification (according to Pre-Grant Publication numbering) indicates that block data, as referred to in claims 4 and 43, is geographic-based data; however, paragraph 0106 indicates that block data is demographic-based,

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such as income, number of cars, family members, or children, and purchase history.

Therefore the Examiner is unclear as to what "block data" refers to or how it is to be defined for claim limitation purposes. For examination purposes, the Examiner will interpret this to mean that "block data" may refer to an address (electronic, physical, or mailing) where the subscription may be delivered.

Appropriate correction is required.

### ***Claim Objections***

**5. Claims 1-3, 9-15, 19-21, 26-28, 43-44, 87-89, and 91 are objected to for the following reasons:**

6. Claims 1-3, 15, 19, 26, 43-44, 87-89, and 91 are objected to because of the following informalities: the terms "CID" and "POS" are used at various and multiple locations throughout these claims. Although these are indicated as consumer identification and point-of-sale, respectively, in Applicant's specification, specification limitations may not be read into the claims; therefore the Examiner suggests spelling out the terms. Appropriate correction is required.

7. Claim 9-14, 20-21, and 27-28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

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Claims 9-14 each recite limitations related to what the contract terms of a subscription are comprised of. MPEP 2106(IV)(B) indicates that a legal document does not appear to be a process, machine, manufacture, or composition of matter and therefore not eligible for patenting; as such, claims 9-14 can be given little or no patentable weight since they solely distinguish from parent claim 1 based on subject matter that is not deemed patentable since not statutory. Therefore claims 9-14 do not further limit claim 1. Appropriate correction is required.

Claim 13 recites the limitation of acceptance of said invitation; however, independent claim 1, from which claim 13 ultimately depends, recites acceptance of said invitation at the second to last element. Therefore 13 does not further limit claim 1. Appropriate correction is required.

Claims 20-21 and 27-28 recite recording at least one (or two) of a list including the periodical name, a subscription price, and an offer or invitation expiration date. The Examiner notes that claim 1 indicates acceptance of the offer at the second to last element of claim 1. The Examiner understands the subscription to be a contract to deliver a periodical for a price, and that in order to make that contract valid, the contract would be required to define the name or title of the periodical and the price to be paid; without such basic terms, the subscription would be invalid or unenforceable. Therefore, in order to have a proper acceptance of the offer at claim 1, the basic terms of name and price must be included at claim 1, and claims 20-21

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and 27-28 do not then further limit claim 1. Additionally, the Examiner notes that since acceptance is indicated at claim 1, any offer expiration date must be merely descriptive material since proper acceptance would require the offer to still be valid according to date; therefore this term can also not further limit. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 16, 19, 24, and 38-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "invitation offer record" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 1 indicates only invitation offer criteria and an invitation code.

Claim 19 recites generating or updating a consumer invitation record, and the Examiner notes that there is no antecedent consumer invitation record to update; thereby implying that this would only entail generating. Therefore the Examiner is uncertain if this indicates only generating, or if updating is possible, or if updating is

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required or optionally performed. For examination purposes, the Examiner will interpret this to mean generating.

Claim 24 recites the limitation "product purchases" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 38-39 recite the limitation "magazine" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-43 and 88-89 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent, a method/process claim must 1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above

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requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

As to claims 1 and 88-89, they fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. The steps of claim 1 and 89 are recited as “receiving,” “storing,” and “transmitting”, however, each of these steps is recognized as insignificant or extra-solution activity that is not able to tie the method to a particular machine or apparatus. The steps of claim 88 are similar, but also include consumer activity or the consumer actively performing the step. Significant activity is generally regarded as activity that centered on generating, solving, calculating, or determining; when the activity is solely insignificant the steps are regarded as performed by a general computer and no special instructions or programming are required in order to define the machine, if one is present or required, as a particular machine. Additionally, none of the steps of claims 1 and 88-89 are positively recited as being performed by a machine – each of the steps may be performed by a person through the use of a machine, or are specifically recited as being performed by a person. Therefore, since there is no indication or recitation of transformation of matter, claims 1 and 88-89 are directed to nonstatutory subject matter.

Claims 2-43 depend from claim 1, but do not resolve the above issues; therefore claims 2-43 are also directed to nonstatutory subject matter.



Claim 87 is drawn to a computer program product comprising code stored on a computer readable medium. As such, claim 87 is drawn to the code itself of the program product, which is a computer listing or program *per se*, and nonstatutory. Please see MPEP § 2106.01(I). The Examiner notes that this is not a Beauregard claim to the medium with the programming embedded thereon; the current claim language indicates that code is stored rather than embedded, and that there is no indication of realizing the functionality of the program until it is loaded onto a computer. Therefore claim 87 is directed to nonstatutory subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**10. Claims 1-44, 87-89, and 91 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (U.S. Patent No. 5,926,796, hereafter Walker).**

Please note that, as a convenience to applicant, the Examiner has pointed out, by **bolding**, optional or intended use language, and included a note as to the ramifications of such language below.

Claim 1: Walker discloses a computer network implemented method, comprising:

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receiving a CID (column:line 9:22-54; Fig. 8; citation hereafter by number only);  
storing said CID in memory in association with an invitation code **when** data associated with said CID meets invitation offer criteria associated with said invitation code (8:58-9:17, 9:22-54, 10:4-25; Fig. 8);  
storing in association with said invitation code contract terms comprising terms for a contract for a subscription to a periodical publication (8:34-47);  
transmitting to an offer terminal data defining said CID and said invitation code **in order to** provide an invitation to a consumer (10:40-53);  
receiving from an acceptance terminal said invitation code in association with said CID subsequent to said transmitting indicating acceptance of said invitation by said consumer (10:40-53); and  
storing said CID in association with a transaction tracking code (9:48-54).

Claim 2: Walker discloses the method of claim 1 further comprising determining whether consumer data associated with said CID meets said invitation offer criteria (10:4-15).

Claim 3: Walker discloses the method of claim 2 wherein said invitation offer criteria comprises criteria for POS data (10:40-53).

Claim 4: Walker discloses the method of claim 2 wherein said invitation offer criteria comprises criteria for block data (9:25-30; Figs. 8 and 11).

Claim 5: Walker discloses the method of claim 2 wherein said invitation offer criteria comprises criteria for preference data (10:4-15; preference indicated by selection of periodical).

Claim 6: Walker discloses the method of claim 2 whereto said invitation offer criteria comprises criteria for profile data (9:25-30; Figs. 8 and 11).

Claim 7: Walker discloses the method of claim 2 wherein said invitation offer criteria comprises criteria for demographic data (9:25-30; Figs. 8 and 11).

Claim 8: Walker discloses the method of claim 2 wherein said invitation offer criteria comprises criteria for magazine purchases (10:4-15; the Examiner understands that a magazine is a periodical; Figs. 5 and 8, "TIME").

Claim 9: Walker discloses the method of claim 1 whereto said contract terms comprise a name of said periodical publication (10:36-40; Figs. 5 and 8, "TIME").

Claim 10: Walker discloses the method of claim 1 wherein said contract terms comprise a price for said subscription (10:56-58; Fig. 5).

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Claim 11: Walker discloses the method of claim 1 wherein said contract terms comprise an expiration date for said invitation (10:19-25, term).

Claim 12: Walker discloses the method of claim 1 wherein said contract terms include terms of an incentive offer (10:19-25, price and term).

Claim 13: Walker discloses the method of claim 12 wherein said terms of said incentive offer include acceptance of said invitation (10:40-53).

Claim 14: Walker discloses the method of claim 12 wherein said terms of said incentive offer include a cash discount (5:60-65).

Claim 15: Walker discloses the method of claim 1 wherein said transmitting comprises transmitting when said CID is involved in a transaction at said offer terminal (10:4-15).

Claim 16: Walker discloses the method of claim 1 further comprising updating an invitation offer record in an invitation offer database to indicate code associated with said record has been used in an invitation offered to a customer (7:41-56).

Claim 17: Walker discloses the method of claim 16 wherein said invitation offer record also stores at least one of the following items: a name of a periodical

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publication (8:58-67, 10:19-25, 10:36-40; Figs. 5, 8, and 11; title or name, or "TIME" or "BUSINESS WEEK"), a subscription price (10:19-25), an offer expiration date, and an incentive offer (5:60-65; 10:4-15).

Claim 18: Walker discloses the method of claim 16 wherein said invitation offer record also stores at least two of the following items: a name of a periodical publication (8:58-67, 10:19-25, 10:36-40; Figs. 5, 8, and 11; title or name, or "TIME" or "BUSINESS WEEK"), a subscription price (10:19-25), an offer expiration date, and an incentive offer (5:60-65; 10:4-15).

Claim 19: Walker discloses the method of claim 1 further comprising generating or updating a consumer invitation record in a consumer invitation database to store a CID and a unique code (9:25-54; Fig. 8).

Claim 20: Walker discloses the method of claim 19 wherein said consumer invitation record also stores at least one of the following items: a name of a periodical publication (9:25-54; Fig. 8), a subscription price (9:25-54, 10:61-65; Figs. 8 and 12), an invitation expiration date, incentive offer (5:60-65), subscription term (9:25-54; Fig. 8).

Claim 21: Walker discloses the method of claim 19 wherein said consumer invitation record also stores at least two of the following items: a name of a

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periodical publication (9:25-54; Fig. 8), a subscription price (9:25-54, 10:61-65; Figs. 8 and 12), an invitation expiration date, incentive offer (5:60-65), subscription term (9:25-54; Fig. 8).

Claim 22: Walker discloses the method of claim 19 wherein said consumer invitation record also stores data indicating whether said invitation has been provided to said consumer (9:25-54; Fig. 8; the Examiner understands that if one has subscribed, the invitation has been provided).

Claim 23: Walker discloses the method of claim 1 further comprises receiving payment for said subscription when receiving from said acceptance terminal said invitation code (10:40-63).

Claim 24: Walker discloses the method of claim 23 further comprising receiving payment for product purchases concurrently with receiving said payment for said subscription (10:56-63; Fig. 12, receipt indicates concurrent purchases).

Claim 25: Walker discloses the method of claim 1 further comprising generating a consumer confirmation record in a consumer confirmation database after receiving from said acceptance terminal said invitation code (9:25-54; Fig. 8).

Claim 26: Walker discloses the method of claim 25 wherein said consumer confirmation record includes a CID and a transaction tracking code (9:25-54; Fig. 8).

Claim 27: Walker discloses the method of claim 26 wherein said consumer confirmation record also includes at least one of the following items: a name of a periodical publication (9:25-54; Fig. 8), a subscription price (9:25-54, 10:61-65; Figs. 8 and 12), a subscription term, a confirmation activation expiration date, an incentive offer (5:60-65), and an incentive offer expiration date.

Claim 28: Walker discloses the method of claim 26 wherein said consumer confirmation record also includes at least two of the following items: a name of a periodical publication (9:25-54; Fig. 8), a subscription price (9:25-54, 10:61-65; Figs. 8 and 12), a subscription term, a confirmation activation expiration date, an incentive offer (5:60-65), and an incentive offer expiration date.

Claim 29: Walker discloses the method of claim 1 wherein at least one criteria of said invitation offer criteria is whether a magazine is purchased (10:4-15).

Claim 33: Walker discloses the method of claim 1 further comprising activating said subscription (12:7-32).

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Claim 40: Walker discloses the method of claim 1 further comprising providing at least two of the following items: a retail store computer system (6:1-4, 6:36-64, 7:18-29), a central computer system (7:18-40); an activation center computer system (11:54-12:32), a publisher computer system (12:29-32), a mailing facility computer system (12:11-32), and a coupon clearing house computer system.

Claim 41: Walker discloses the method of claim 1 further comprising providing at least three of the following items: a retail store computer system (6:1-4, 6:36-64, 7:18-29), a central computer system (7:18-40); an activation center computer system (11:54-12:32), a publisher computer system (12:29-32), a mailing facility computer system (12:11-32), and a coupon clearing house computer system.

Claim 42: Walker discloses the method of claim 1 further comprising storing POS data in association with CIDS in a consumer data database (9:25-54; Fig. 8).

Claim 43: Walker discloses the method of claim 42 wherein said consumer data database also stores in association with CIDs at least one of the following items: profile data (9:25-54; Fig. 8; name, address), preference data (9:25-54; Fig. 8; periodical name), demographic data, and block data.

Claim 44: Walker discloses a computer network system, comprising:  
a central processor and associated memory (6:36-64, 7:18-29, 7:41-56);



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a terminal **for receiving** a CID (6:1-4, 6:36-64);

a consumer data database storing data in association with CIDs (9:25-54; Fig. 8);

memory structure **for storing** said CID in association with an invitation code

**when** data in said consumer data database associated with said CID meets

invitation offer criteria associated with said invitation code (6:36-64, 7:41-56, 9:25-54;

Fig. 8);

memory structure **for storing** in association with said invitation code contract terms comprising terms for a contract for a subscription to a periodical publication (7:41-56, 8:34-47);

an offer terminal (6:1-4, 6:36-64);

a network transmitter **for transmitting** to said offer terminal data defining said CID and said invitation code **in order to** provide an invitation to a consumer (7:18-40);

an acceptance terminal (10:40-53);

a network receiver **for receiving** from said acceptance terminal said invitation code in association with said CID indicating acceptance of said invitation by said consumer (9:25-54); and

memory structure **for storing** said CID in association with a transaction tracking code (7:41-56, 9:25-54).

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Claim 87: Walker discloses a computer network program product, comprising code stored on a computer readable medium **for performing** the following steps **when** loaded on networked computers:

receiving a CID (9:22-54);

storing said CID in memory in association with an invitation code **when** data associated with said CID meets invitation offer criteria associated with said invitation code (8:58-9:17, 9:22-54, 10:4-25; Fig. 8);

storing in association with said invitation code contract terms comprising terms for a contract for a subscription to a periodical publication (8:34-47);

transmitting to an offer terminal data defining said CID and said invitation code **in order to** provide an invitation to a consumer (10:40-53);

receiving from an acceptance terminal said invitation code in association with said CID subsequent to said transmitting indicating acceptance of said invitation by said consumer (10:40-53); and

storing said CID in association with a transaction tracking code (9:48-54).

Claim 88: Walker discloses a computer implemented method, comprising:

a consumer providing to a POS terminal their CID (9:22-54; Fig. 8);

storing said CID in memory in association with an invitation code **when** data associated with said CID meets invitation offer criteria associated with said invitation code (8:58-9:17, 9:22-54, 10:4-25; Fig. 8);

storing in association with said invitation code contract terms comprising terms for a contract for a subscription to a periodical publication (8:34-47);

said consumer receiving at a POS terminal an invitation including data defining said CID and said invitation code (10:40-53);

said consumer providing to a POS terminal said invitation code in association with said CID subsequent to receiving said invitation, **thereby indicating** acceptance of said invitation by said consumer (10:40-53); and

storing said CID in association with a transaction tracking code (9:48-54).

Claim 89: Walker discloses a computer network implemented method, comprising:

receiving a CID associated with a consumer (9:22-54; Fig. 8);

storing said CID in memory in association with an invitation code **when** data associated with said CID meets invitation offer criteria associated with said invitation code (8:58-9:17, 9:22-54, 10:4-25; Fig. 8);

storing in association with said invitation code contract terms comprising terms for a contract for at least one of a product and a service (8:34-47);

transmitting to an offer terminal data defining said CID and said invitation code **in order to** provide an invitation including an offer for said at least one of a product and a service to said consumer (10:40-53);

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receiving from an acceptance terminal said invitation code in association with said CID subsequent to said transmitting indicating acceptance of said invitation by said consumer (10:40-53); and  
storing said CID in association with a transaction tracking code (9:48-54).

Claim 91: Walker discloses a computer network system, comprising:  
a central processor and associated memory (6:36-64, 7:18-29, 7:41-56);  
a terminal **for receiving** a CID associated with a consumer (6:1-4, 6:36-64);  
a consumer data database storing data in association with CIDs (9:25-54; Fig. 8);  
memory structure **for storing** said CID in association with an invitation code  
**when** data in said consumer data database associated with said CID meets  
invitation offer criteria associated with said invitation code (6:36-64, 7:41-56, 9:25-54;  
Fig. 8);

memory structure **for storing** in association with said invitation code contract  
terms comprising terms for a contract for at least one of a product and a service  
(7:41-56, 8:34-47);

an offer terminal (6:1-4, 6:36-64);

a network transmitter **for transmitting** to said offer terminal data defining said  
CID and said invitation code in order to provide an invitation to purchase said at  
least one of said product and said service to said consumer (7:18-40);

an acceptance terminal (10:40-53);

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a network receiver **for receiving** from said acceptance terminal said invitation code in association with said CID indicating acceptance of said invitation by said consumer (9:25-54); and

memory structure **for storing** said CID in association with a transaction tracking code (7:41-56, 9:25-54).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

#### **11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

##### **Walker.**

Claim 32: Walker discloses the method of claim 1, but does not explicitly disclose wherein said invitation is provided to said consumer via printing at an in-store printer. Walker, however, teaches a printer for printing paperwork (7:7-9), and providing subscription cards, either from the single issue or a comparable alternative (10:12-18) and that the printed receipt may contain the authorization code (10:56-58). The Examiner understands that printing the subscription card with the invitation on an in-store printer is one of a limited number of predictable options available for providing a comparable subscription card.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker in order to print the invitation via an in-store printer.

The rationale for combining in this manner is that printing the subscription card with the invitation on an in-store printer is one of a limited number of predictable options available for providing a comparable subscription card.

Claim 34: Walker discloses the method of claim 33, but does not explicitly disclose wherein said activating comprises receiving at an activation center a telephone call from said consumer. Walker, however, teaches including customer service information, including an 800 number to call (10:64-11:4; Fig. 12). The Examiner understands that requiring the consumer to call in the activation rather than performing it for the consumer is one of a limited number of predictable options available for activation notice options.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker in order to require the consumer to call in the activation.

The rationale for combining in this manner is that requiring the consumer to call in the activation rather than performing it for the consumer is one of a limited number of predictable options available for activation notice options.

Claim 35: Walker discloses the method of claim 33, but does not explicitly disclose wherein said activating comprises receiving a mailing from said consumer.

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Walker, however, teaches including customer service information, including an 800 number to call (10:64-11:4; Fig. 12), and using the subscription card from within a purchased issue (10:12-18). The Examiner understands subscription cards from within a publication to be pre-addressed, ready to mail subscription invitations. The Examiner understands that requiring the consumer to mail in the activation rather than performing it for the consumer is one of a limited number of predictable options available for activation notice options.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker in order to require the consumer to mail in the activation.

The rationale for combining in this manner is that requiring the consumer to mail in the activation rather than performing it for the consumer is one of a limited number of predictable options available for activation notice options.

Claim 36: Walker discloses the method of claim 33, but does not explicitly disclose wherein said activating comprises receiving activation data transmitted by said consumer over the Internet. Walker, however, teaches including customer service information, including an 800 number to call (10:64-11:4; Fig. 12), using the subscription card from within a purchased issue (10:12-18), and transmitting the subscription to the retail subscription system, a fulfillment house, and the periodical publisher either by mail or electronically (11:54-12:32). The Examiner understands that requiring the consumer to transmit the activation over the internet rather than

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performing it for the consumer is one of a limited number of predictable options available for activation notice options.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker in order to require the consumer to transmit the activation over the internet.

The rationale for combining in this manner is that requiring the consumer to transmit the activation over the internet rather than performing it for the consumer is one of a limited number of predictable options available for activation notice options.

Claim 37: Walker discloses the method of claim 1, but does not explicitly disclose further comprising printing said invitation and including a printed unique bar code. Walker, however, teaches a printer for printing paperwork (7:7-9), providing subscription cards, either from the single issue or a comparable alternative (10:12-18), that the printed receipt may contain the authorization code (10:56-58), and that the initial periodical purchase and information is identified by scanning a bar code or UPC (10:34-40). The Examiner recognizes that offer acceptance is already indicated at claim 1, the second-to-last element; therefore the bar code as included is, apparently, used as a way of identifying the invitation, subscription, and/or terms. The Examiner then understands that printing the invitation and including a unique bar code is one of a limited number of predictable options available for providing a comparable subscription card.



Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker in order to print the invitation and include a unique bar code.

The rationale for combining in this manner is that printing the invitation and including a unique bar code is one of a limited number of predictable options available for providing a comparable subscription card.

Claim 38: Walker discloses the method of claim 37, but does not explicitly disclose wherein magazine name, magazine subscription price, and offer expiration date are encrypted in said unique bar code. Walker, however, teaches including customer service information, including an 800 number to call, in the printed information (10:64-11:4; Fig. 12), that the information logged and saved includes the periodical name and pricing (9:25-54; Fig. 8; and 8:58-9:17), and that the printed information includes the periodical name and pricing and subscription pricing (Fig. 12). The Examiner recognizes that offer acceptance is already indicated at claim 1, the second-to-last element; therefore the offer expiration date is fairly immaterial – the offer is indicated as accepted regardless of expiration date. Therefore, the Examiner understands that encrypting a magazine name, subscription pricing, and offer expiration date in a unique bar code is one of a limited number of predictable options available for printed invitations.

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Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker in order to encrypt a magazine name, subscription pricing, and offer expiration date in a unique bar code.

The rationale for combining in this manner is that encrypting a magazine name, subscription pricing, and offer expiration date in a unique bar code is one of a limited number of predictable options available for printed invitations.

Claim 39: Walker discloses the method of claim 1, but does not explicitly disclose wherein magazine name, magazine subscription price and offer expiration date are encrypted in said transaction tracking code. Walker, however, teaches including customer service information, including an 800 number to call, in the printed information (10:64-11:4; Fig. 12), that the information logged and saved includes the periodical name and pricing (9:25-54; Fig. 8; and 8:58-9:17), and that the printed information includes the periodical name and pricing and subscription pricing (Fig. 12). The Examiner recognizes that offer acceptance is already indicated at claim 1, the second-to-last element; therefore the offer expiration date is fairly immaterial – the offer is indicated as accepted regardless of expiration date. Therefore, the Examiner understands that encrypting a magazine name, subscription pricing, and offer expiration date in a transaction tracking code is one of a limited number of predictable options available for printed invitations.

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Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walker in order to encrypt a magazine name, subscription pricing, and offer expiration date in a transaction tracking code.

The rationale for combining in this manner is that encrypting a magazine name, subscription pricing, and offer expiration date in a transaction tracking code is one of a limited number of predictable options available for printed invitations.

**12. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Herz et al. (U.S. Patent No. 6,571,279, hereafter Herz).**

Claim 30: Walker discloses the method of claim 1, but does not explicitly disclose wherein at least one criteria of said invitation offer criteria is whether said consumer user is in a specified top fraction of spenders. Walker, however, teaches using a selection or purchase of a single periodical as target criteria (10:4-10, 10:34-53) and Herz further teaches an advertising targeting system (1:16-21) that employs user profiles with data such as income ranges, magazine subscriptions, and purchasing habits to target utilizing spending habits (6:16-33) and provide promotions tailored to preferences at a point of purchase (23:59-64). The Examiner understands that using criteria indicating a specified top fraction of spenders is one of a limited number of predictable options available for targeting consumers.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the point of sale subscription promotion and enrollment of Walker with the point of purchase spending or purchasing targeting of Herz in

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order to utilize invitation offer criteria of whether the consumer is in a specified top fraction of spenders.

The rationale for combining in this manner is that using criteria indicating a specified top fraction of spenders is one of a limited number of predictable options available for targeting consumers.

Claim 31: Walker discloses the method of claim 1, but does not explicitly disclose wherein said invitation is provided to said consumer via direct mail. Walker, however, teaches providing a subscription offer at the point of sale (10:4-10, 10:34-53) and Herz further teaches that an obvious way of communicating promotions is via direct mail rather than in-store or at the point of purchase (23:59-67). The Examiner understands that direct mail is one of a limited number of predictable options available for providing an invitation.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the point of sale subscription promotion and enrollment of Walker with the direct mail alternative of Herz in order to provide an invitation to a consumer via direct mail.

The rationale for combining in this manner is that Herz explicitly teaches direct mail as an obvious alternative (Herz at 23:59-67) and also that direct mail is one of a limited number of predictable options available for providing an invitation.

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13. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it meets the claim. See *e.g. In re Collier*, 158 USPQ 266, 267 (CCPA 1968) (where the court interpreted the claimed phrase “a connector member for engaging shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements” and where the court interpreted the claimed phrase “said ferrule-forming member being crimpable onto said shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements.... “[t]he ferrule or connector member is crimpable but not required, structurally, to be crimped .... These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefore be relied on to distinguish from the prior art.”).

The Examiner has analyzed the claim language and phrasing as indicated by the **bold** sections or words above, and determined that the phrasing following the **bolded** word(s) is not required due to the terminology being optional or intended use or expected results, in conformity with MPEP § 2111.04.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT D. GARTLAND whose telephone number is 571-270-5501. The examiner can normally be reached on 7:30-6:00 EST Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D. G./  
Examiner, Art Unit 3622

/John Van Bramer/  
John Van Bramer  
Examiner, Art Unit 3622